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Supreme Court of the United States

OCTOBER TERM, 1942.

No. **243**

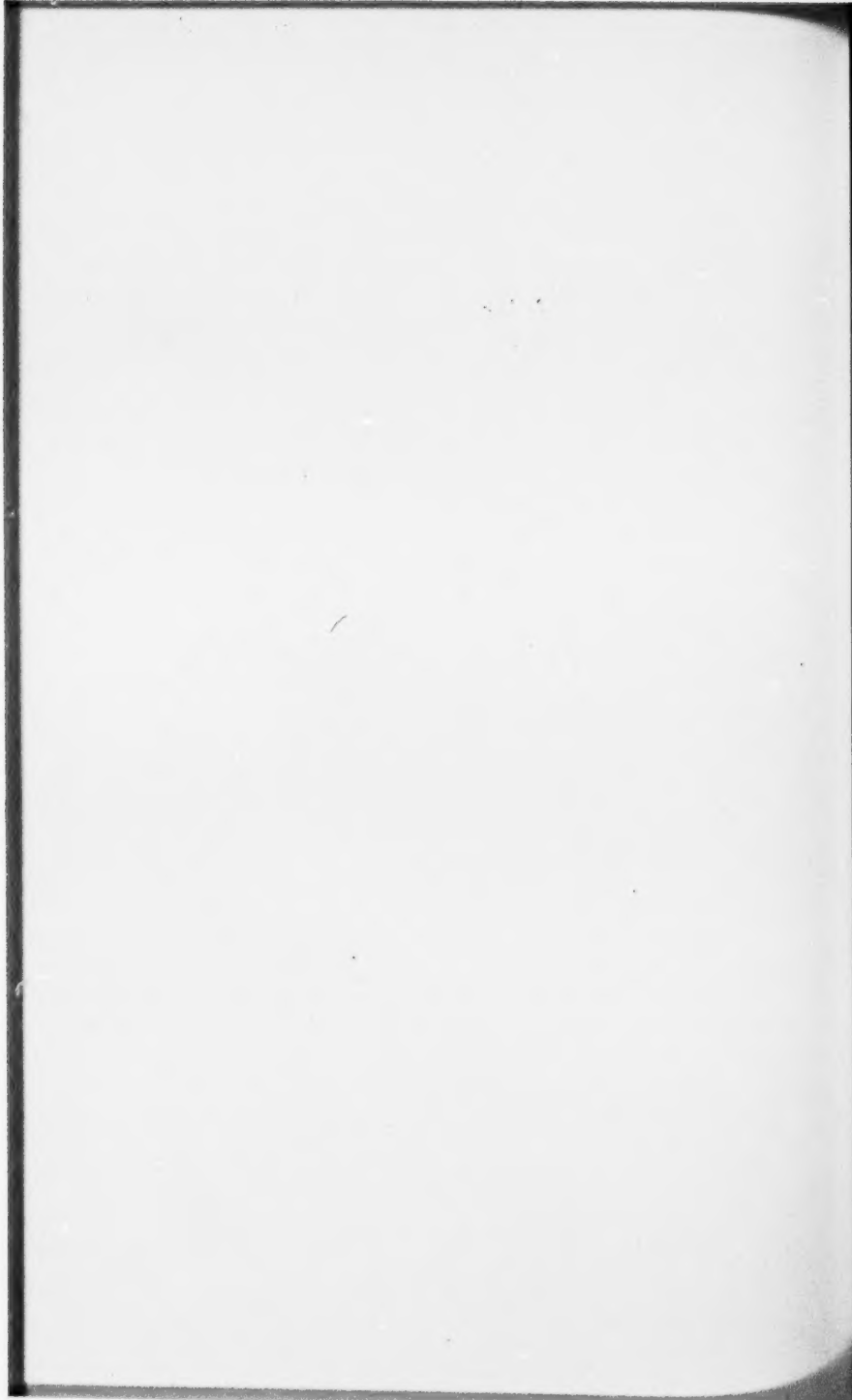
GENERAL RADIO COMPANY,
Petitioner,

vs.

ALLEN B. DU MONT LABORATORIES, INC.,
Respondent.

**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE THIRD CIRCUIT AND BRIEF IN SUP-
PORT THEREOF**

DEAN S. EDMONDS,
R. MORTON ADAMS,
BALDWIN GUILD,
GEORGE E. FAITHFULL,
W. PETERS BLANC,
Counsel for Petitioner.



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IN THE
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OCTOBER TERM, 1942

GENERAL RADIO COMPANY,

Petitioner,

vs.

ALLEN B. DuMONT LABORATORIES, INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI

*To the Honorable, the Chief Justice and the Associate
Justices of the Supreme Court of the United States:*

Your petitioner, General Radio Company, prays that a writ of certiorari issue to review the decree of the United States Circuit Court of Appeals for the Third Circuit, entered herein on May 12, 1942 (R. 311). Rehearing and reconsideration by that Court were requested and were denied June 3, 1942, and June 12, 1942, respectively (R. 325 and 332).

A certified transcript of the record in the case, including the proceedings in the Circuit Court of Appeals, is furnished herewith in compliance with Rule 38 of this Court.

Summary Statement of the Matter Involved

This is a suit in equity brought by petitioner against respondent in the United States District Court for the District of Delaware for infringement of claims 4, 6, 7, 8, 9,

10, 11, 12 and 13 of Bedell reissue patent No. 20,945 granted December 13, 1938 on application filed August 18, 1937. The reissue patent is founded upon original patent No. 1,707,594, for a "Device for Indicating Oscillograph Curves as Stationary" granted April 2, 1929, on an application filed May 7, 1927. Copies of the original and reissue patents may be found at pages 71 and 63 of the record. The District Court held the claims in suit of the reissue patent valid and infringed (R. 127, 138). The Court of Appeals, without consideration of the merits of the invention, reversed the decision of the District Court, holding the reissue invalid on the ground that the error of the original patent sought to be corrected by the reissue did not arise by any "inadvertence, accident or mistake" contemplated by the Reissue Statute and on the additional ground that there had been unreasonable delay in discovering the error and applying for reissue* (R. 315).

The invention relates to a device known as a cathode-ray oscillograph, the purpose of which is to analyze the characteristics of an electric current flowing in a circuit and to indicate these characteristics in the form of a curve projected upon a fluorescent screen. Prior to the invention the existing cathode-ray oscillograph comprised a cathode-ray tube which projected a beam of electrons upon a fluorescent screen and two sets of deflecting plates positioned around this beam, one set of plates being actuated by the incoming current under examination and the other by an independent current in an oscillator circuit which was synchronized as closely as possible to the frequency of the incoming current. These plates deflected the electron beam both vertically and horizontally thereby causing it to trace upon the fluorescent screen a curve representing the characteristics of the current under examination. The device, however, was unable to maintain the curve

*The full text of the Reissue Statute, R. S. 4916, will be found in the Appendix, pages 31-2.

upon the screen in a stationary position due to the impossibility of maintaining the oscillator in synchronism with the frequency of the incoming current. Consequently, in order to read the curve accurately, constant manual readjustment of the oscillator was required.

Bedell discovered that the introduction of a small voltage from the electric current under examination into the oscillator circuit would lock the oscillator into absolute synchronization with the frequency of the current under examination and that the curve traced upon the screen would consequently remain stationary without manual adjustment. Bedell accomplished this by an appropriate coupling. The introduction of this additional element into the old combination created a new combination of elements consisting of a cathode-ray tube, deflecting plates, and a coupling between the conductor of the current under examination and the oscillator circuit. It has not been questioned in this case that the invention is for a true combination. Each of the elements is so related to the others and so cooperates with them that together they produce a new result impossible of attainment in the absence of that relationship.* Consequently, Bedell was entitled to claims covering the new combination as such and having a scope which could not be evaded by the mere substitution of equivalents.

Claims 1 to 6 of the original patent were accordingly directed to the combination. Claim 1, which is typical, reads as follows:

“In a device of the type described, a cathode-ray tube, two sets of deflecting elements fixed in position with respect to said tube and with respect to each other

*Electric Cable Joint Co. v. Brooklyn Edison Co., Inc., 292 U. S. 69, 79; Leeds & Catlin v. Victor Talking Machine Co., 213 U. S. 301, 318; Gill v. Wells, 22 Wall. 1, 26; Robinson on Patents, Vol. II, Sec. 528.

for deflecting the cathode beam periodically, and means for indicating the curve formed by the deflected beam as stationary."

It has long been the established practice, approved by the Patent Office, to claim a combination by defining the elements of the combination by the terms "means" followed by the statement of the function performed by the means in the combination.* This is apparently what the solicitor was attempting to do in drafting claims 1 to 6 of the original patent and the Patent Office apparently thought he had succeeded in doing so since it allowed the claims.

Although the Court of Appeals held claims 1-6 invalid as a matter of law because of their form, there is nothing in the facts of the case to indicate that the patentee, petitioner or anyone else ever doubted that the claims were not in proper form until present counsel so advised petitioner in 1937. The pertinent facts follow: The application was prepared by Munn & Co. (R. 72), now and for many years nationally known patent attorneys of good reputation. There is no suggestion that the prosecution of the application for the original patent was other than routine. As stated the Patent Office granted the patent and thus placed its seal of approval on the form

*The rule of the Patent Office was distinctly stated as early as 1904 in *Young v. Eick*, 113 O. G. 547, 1904 C. D. 465: "The use of the word 'means' limited by a statement of function has long been recognized as the proper method of stating an element of a combination claim." See also *Ex parte Walker*, *Mizer & Dearsley*, 21 U. S. P. Q. 51, 1928; *Ex parte Dearsley*, 21 U. S. P. Q. 54, 1928; *Ex parte Louis N. D. Williams*, 2 U. S. P. Q. 93, 1929. The same rule was applied in the Federal Courts, *Morley Sewing Machine Co. v. Lancaster*, 129 U. S. 263, 286; *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405, 422; *Arnold v. Tyden*, 193 Fed. 410, C. C. A. 7, 1911; *Bake-Rite Mfg. Co. v. Tomlinson, et al.*, 16 F. (2d) 556, C. C. A. 9, 1926; *Gilchrist Co. et al. v. Kar-Lac Co.*, 29 F. (2d) 153, C. C. A. 7, 1928.

and validity of its claims. Throughout the eight-year period after the grant of the original patent until the filing of the reissue, the original patent was subjected to scrutiny by people well acquainted with the patent law and by counsel of established reputation and of unquestionable competence and although they had every reason to be critical of the patent none of them ever suggested that the patent was defective or invalid because of any defect in the form of the original claims. During this eight-year period licenses to operate under the patent were taken out by the petitioner and by the R. L. Bart Laboratories of California (R. 192-3). Some few years later petitioner bought the patent outright (R. 255). Respondent's president Du Mont, a man skilled in patent matters, had previously arranged to acquire a license from Dr. Bedell. On the sale of the patent to petitioner, Du Mont was so anxious to obtain a license from the new owner, that he consulted counsel to see whether he could compel petitioner to grant him a license (R. 194). The license was willingly granted to him and Du Mont operated under this license and paid royalties for over a year until the end of 1935 (R. 12-13).

At the end of 1935, when the question of transferring the license to Du Mont's newly formed corporation arose, an opinion on validity was obtained by respondent from Bacon & Thomas of Washington, and from Darby & Darby of New York. These counsel suggested that certain prior art might anticipate Bedell but did not suggest that Bedell's invention was improperly claimed (R. 13-14; Exh. 2-A, R. 116-8; Exh. 2, R. 115). Respondent declined to accept a license and present counsel were consulted by petitioner first to renew negotiations and finally in January, 1937, to bring suit.

Present counsel, in its preparation of the case for trial, came to the conclusion that the form of claims 1 to 6 was such that it might render them invalid. On careful analysis, present counsel noticed that the third element of the claims, namely the coupling means, is not actually defined

in terms of the function which it performs in the combination but in terms of the function or result to be obtained by the combination as a whole. In this respect the claims are defective in form. It is a widely accepted rule, however, that claims should be construed in the light of the specification and limited to the means there described. In the light of this rule, the conclusion of counsel that claims 1 to 6 were defective in form did not necessarily lead to a conclusion that they were invalid since the specification of the patent disclosed very exactly the metes and bounds of the invention and the means actually invented by Bedell. In order however to avoid any possible question as to the validity of the claims, counsel advised petitioner to reissue the patent (R. 123). This was the first time in the eight years since the grant of the patent that the form of the claims had been criticized. This report was made on February 11, 1937, and reissue was applied for promptly thereafter on the stated ground that the claims might be construed to be functional and hence invalid (R. 59-61).

The reissue was granted on December 13, 1938. By the reissue, claims 1 to 6 of the original were cancelled and narrowed claims 6 to 13 allowed. Present claims 1 to 5 were carried over from the original patent either without change or with superficial alterations only. The specifications and drawings were corrected as to certain details but the propriety of these changes has not been challenged.

The District Court in a considered opinion (R. 127-38) found the invention to be one of real merit (R. 133), novel and patentable and that it had been admittedly appropriated by defendant with respect to the broad claims in suit. The issue of infringement with respect to certain of the more specific claims in suit was also resolved in petitioner's favor (R. 134-5). The District Court rejected the technical defenses relating to the propriety of the reissue, holding on the evidence that neither the present owner, petitioner, nor Professor Bedell, the patentee, was aware of the defect in the original patent until it was called to their atten-

tion by present counsel while preparing the instant case for trial; that the reissue was filed because of counsel's advice that claims of the original patent were in such form that they might be held invalid; that in filing the reissue plaintiff made no misrepresentation to the Patent Office; that on the contrary its representative attended before the Examiner in the Patent Office so that the Examiner had ample opportunity to satisfy himself as to when the plaintiff learned of the defect in certain claims of the patent and that under the evidence in the case there was no unreasonable delay in applying for the reissue (R. 136-7).

The Court of Appeals did not pass on the merit of the invention* but reversed the lower court solely on technical grounds going to the propriety of the reissue. The Court of Appeals held, as a matter of law, that the action of a solicitor in drafting claims of a patent in functional form could not constitute "inadvertence, accident or mistake" within the meaning of the reissue statute and accordingly held the reissue patent in suit invalid (R. 320-1).

Also, and without regard to the evidence or the findings of fact of the District Court, the Court of Appeals held that the reissue patent was invalid for unreasonable delay. This decision was based on the Court's conclusion that since the functional nature of the claims appeared on the face of the original patent, the invalidity of these claims was obvious as a matter of law and should have been apparent to anyone with even a rudimentary knowledge of patent law. Consequently the Court held that an obligation arose to correct the patent immediately on its issuance. The period intervening between the grant of the original patent and the reissue application being eight years, the Court held the reissue patent invalid for laches even though the purpose of the reissue was to narrow the claims (R. 321-4).

*As to the merits the Court merely said "The invention and its place in the art are fully described in the opinion of the district court . . ." (R. 316).

Petitioner filed a petition for rehearing which was denied in a supplemental opinion (R. 284, 312). Petitioner also filed a petition for reconsideration which was denied without opinion (R. 326, 332).

The Questions Presented

1. Can the action of a patent solicitor in drafting a claim which is functional in form when construed without reference to the specification constitute "inadvertence, accident, or mistake" within the meaning of the Reissue Statute?

2. Where a defect in a patent raises a question of validity which is wholly one of law on the face of the patent, can a patentee be charged with unreasonable delay in failing to disclaim or reissue before a court has passed on the validity of the patent?

3. Where a claim for a combination of elements is functional in form when construed without reference to the specification, is the claim necessarily invalid as a matter of law even though on reference to the specification there can be no doubt as to the identity of the combination which the claim seeks to define?

Reasons for Granting the Writ

1. The decision of the Court of Appeals that, as a matter of law, the action of a patent solicitor in drafting a claim which is functional in form when construed without reference to the specification does not constitute "inadvertence, accident, or mistake" within the meaning of the reissue statute is in conflict with decisions of this Court

and of the Circuit Courts of Appeals for the First, Second, Fourth, Sixth, Seventh and Ninth Circuits.

Topliff v. Topliff, 145 U. S. 156;

O'Reilly v. Morse, 15 How. 62;

Houghton v. Whitin Machine Works, 153 Fed. 740 (C. C. A. 1st); *Autopiano Co. v. American Player Action Co.*, 222 Fed. 276 (C. C. A. 2nd); *Crown Cork & Seal Co. v. Aluminum Stopper Co.*, 108 Fed. 845 (C. C. A. 4th); *Gross v. Norris*, 26 F. (2d) 898, affirming 18 F. (2d) 418 (C. C. A. 4th); *American Automotoneer Co. v. Porter*, 232 Fed. 456 (C. C. A. 6th); *Van Kannel Revolving Door Co. v. Winton Hotel Co.*, 276 Fed. 234 (C. C. A. 6th); *Moneyweight Scale Co. v. Toledo Computing Scale Co.*, 187 Fed. 826 (C. C. A. 7th); *Perfection Disappearing Bed Co. v. Murphy Wall Bed Co.*, 266 Fed. 698 (C. C. A. 9th).

2. The decision of the Court of Appeals that, where a defect in a patent raises a question of validity which is wholly one of law on the face of the patent, a patentee can be charged with unreasonable delay in failing to disclaim or reissue before a court has passed on the validity of a patent is in conflict with decisions of this Court.

O'Reilly v. Morse, 15 How. 62;

Seymour, et al. v. McCormick, 19 How. 96;

Gage v. Herring, 107 U. S. 640;

Yale Lock Mfg. Co. v. Sargent, 117 U. S. 536.

3. The decision of the Court of Appeals that a claim for a combination of elements, functional in form when construed without reference to the specification, is necessarily invalid as a matter of law even though on reference to the specification there can be no doubt as to the identity of the combination which the claim seeks to define, is in conflict with decisions of this Court and of the Courts of Appeals for the Second, Fourth, Sixth, Seventh and Ninth

Circuits and the Court of Appeals for the District of Columbia.

Under the conflicting decision of the Court of Appeals for the District of Columbia, the Patent Office is currently granting patents which are absolutely void under the present decision.

Seymour v. Osborne, 11 Wall. 516;
Mitchell v. Tilghman, 19 Wall. 287;
The Corn-Planter Patent, 23 Wall. 181;
Outlook Envelope Co. v. General, etc., Co., 239 Fed. 877 (C. C. A. 2nd); *Engineering and Research Corporation, et al. v. Horni Signal Corporation*, 98 F. (2d) 682 (C. C. A. 2nd); *Bisight Co. v. Onepiece Bifocal Lens Co.*, 259 Fed. 275 (C. C. A. 4th); *Demco v. Doughnut Mach. Corp.*, 62 F. (2d) 23 (C. C. A. 4th); *United Shoe Mach. Corp. v. H. Gordon Co.*, 59 F. (2d) 903 (C. C. A. 6th); *Ford Motor Co. v. Gordon, etc., Co.*, 87 F. (2d) 390 (C. C. A. 6th); *Arnold v. Tyden*, 193 Fed. 410 (C. C. A. 7th); *American Can Company v. Hickmott etc. Company*, 142 Fed. 141 (C. C. A. 9th); *Raytheon Mfg. Co. of Newton, Mass. v. Coe*, 96 F. (2d) 527 (App. D. C.).

Wherefore it is respectfully submitted that this petition for a writ of certiorari to the Circuit Court of Appeals for the Third Circuit should be granted.

DEAN S. EDMONDS,
 R. MORTON ADAMS,
 BALDWIN GUILD,
 GEORGE E. FAITHFULL,
 W. PETERS BLANC,
Counsel for Petitioner.

Dated: New York, N. Y., July 16, 1942.

